



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO. 08/243,638	FILING DATE 05/16/94	FIRST NAMED INVENTOR ABELON	ATTORNEY DOCKET NO. 03058004001
-------------------------------	-------------------------	--------------------------------	------------------------------------

DAVID L. FEIGENBAUM
FISH & RICHARDSON
225 FRANKLIN ST.
BOSTON MA 02110-2804

B3M1/0319

EXAMINER
YOUNT, S

ART UNIT
2411

PAPER NUMBER

DATE MAILED:

12
05/19/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Please see attached letter.

Office Action Summary

Application No.
08/243,638

Applicant(s)
Daniel H. Abelow

Examiner
Steven R. Yount

Group Art Unit
2411



☒ Responsive to communication(s) filed on Nov 21, 1996

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5 and 7-42 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 36 and 37 is/are allowed.

☒ Claim(s) 1-5, 7-35, and 38-42 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2411

DETAILED ACTION

1. Applicant's arguments with respect to claims 1-5, 7-35 and 38-42 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7, 9-11 and 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKenna et al. (US 4,816,904).

A. As to claims 1, 7, 9 10 and 14 McKenna discloses a system (television and market research data collection system) for use with a product (a television and/or cable television programming or service) comprising a user interface (data collection unit 21 and/or wand 35) associated with the product which enables bi-directional communication between the user and the product of local information concerning use of the product (*e.g.*, qualitative ratings of programs and responses to survey questions, col. 5, lines 43-47). Note that Applicants specification, at page 33, specifically defines Products as including services. McKenna also collects information on mode of TV used, identities of viewers and which programs are viewed. Responding to a survey presented on the television screen is interactive because it requires action

Art Unit: 2411

collects information on mode of TV used, identities of viewers and which programs are viewed. Responding to a survey presented on the television screen is interactive because it requires action on the part of the user. Col. 13, lines 1-23. McKenna discloses a triggering mechanism (survey push-button) at col. 7, lines 32-37, which triggers this interactive collection of information from the user. Product information (*e.g.*, survey responses, identities of viewers, which programs are viewed. *etc.*) is communicated to a remote party other than the user. Col. 1, lines 21-25 and col. 3, lines 1-6.

McKenna differs from Applicant's invention in that McKenna does not specifically disclose that the interactive collection of information from the user is at times based on the local information concerning use of the product. However, it would have been obvious to one skilled in the art to collect survey responses relating to qualitative ratings of the programs or to products purchased at times *after* the programs or commercials have been viewed, because the information collected would be more useful.

McKenna suggests a "means for taking action" with respect to the product or the user interface based on the product information at col. 2, lines 21-23. It would have been obvious to one skilled in the art to adopt the more effective commercials or the programming which received higher "qualitative ratings," which would constitute "taking action" with respect to the product. Thus, providing means for taking such action would have been similarly obvious.

B. As to claim 2, McKenna differs from Applicant's invention in that McKenna does not specifically disclose an authoring system. Authoring systems were well

Art Unit: 2411

known at the time of the invention. It would have been obvious to one of ordinary skill in the art to include an authoring system to aid in producing the user surveys, so that the content of the surveys could be updated from time to time. Someone or something has to manage and write the programs, commercials and surveys used in McKenna. An authoring system would naturally be used to do this.

C. As to claim 3 and 15, McKenna differs from Applicant's invention in that McKenna does not specifically disclose that the means for taking action is responsive to the results of an analyzer. However, it was well known at the time of the invention to analyze survey results. It would have been obvious to include an analyzer to analyze the survey results so that more effective alternate programming or commercials could be presented. Changing the programming or commercials would change the interaction permitted by the user.

D. As to claim 4, it would have been obvious to one skilled in the art to change the content of the information collected so that the collected information would reflect current programming since television programming and commercials are known to change from time to time.

E. As to claims 5, 20, 21 and 22, the product module (data collection device) can be selectively enables and disabled. Col. 7. Lines 32-35. Also, simply turning on and off the TV or cable box in McKenna would allow selective enabling and disabling.

F. As to claim 11, McKenna differs from Applicant's invention in that McKenna does not specifically disclose that the nature of the queries in McKenna are determined by the

Art Unit: 2411

nature of the use of the product. However, it would have been obvious to base the survey questions on whether or not the user had viewed a particular program or commercial because then the information collected would be more useful.

G. As to claim 13, the module in McKenna clearly includes hardware. Software for controlling the module is suggested by the brief description of Fig. 15 as a "subroutine."

H. As to claim 16, McKenna discloses a removable memory devices, wire and broadcast transmission at col. 3. Lines 22-46.

I. As to claim 17, the first sentence of the abstract discloses multiple users and hence multiple products (*e.g.*, multiple televisions or multiple programs).

J. As to claims 18 and 19, it would have been obvious to present the survey questions in "natural language" to make the system easier to use. Also, user interfaces in multiple natural languages are well known in the art. For example, ATM machines presenting questions in multiple languages have been around since at least the late 1980's. One would have been motivated to use such an interface since not all persons speak the same language.

4. Claims 1, 8, 12, 23-35 and 38-42 are rejected under 35 U.S.C. 103(a) as unpatentable over "How to use Your Computer to Effect Change," IAC Trade and Industry Database, v15, n3, pS7(2), March 1993 ("IAC").

A. As to claims 1, 23, 29 and 32, the IAC article generally discloses a method for aiding design of a product which involves creating a first version of a product (PC hardware and

Art Unit: 2411

software, see first sentence of text), accumulating information on use of the product by a user in an on-line forum (see third paragraph of text). The on-line forum permits users to supply feedback on use of a product to the manufacturer/designer of the product and is interactive, two-way and bi-directional (the manufacturers respond to communications from the users).

Redesigning the product in accordance with information recovered is suggested by lines 7-8 of the third paragraph ("post . . . ideas for new products and features . . .") and the last sentence of the fifth paragraph ("Be courteous, and be sure to provide concrete suggestions for change.").

Also, note that an on-line information collection forum associated with a product, although not integrally included with the product, is within the definition of "included" per Applicant's specification. Specification at pages 33-34.

Even if an on-line forum associated with a PC hardware or software product was not interpreted as included with the product, the on-line services on which these forums are maintained are themselves "products," including software products which implement the on-line service (note that Applicants specification, at page 33, specifically defines products as including services). The article does not specifically disclose that the on-line services include user forums related to their own service. However, it would have been obvious to one skilled in the art to do so, for the benefits disclosed in the article. In such a case, the user feedback element would be included with the product. Also, at the time of the invention, many software products, particularly business and financial software products, were available through on-line service

Art Unit: 2411

providers. It would have been particularly obvious to one skilled in the art to set up user forums with the on-line service providers, such as are described in the IAC article for these products. This would also constitute a user feedback element included with the product.

The IAC article differs from Applicant's invention in that IAC does not specifically disclose that the recovered information is "analyzed" before it is used to redesign the product. It would have been obvious to analyze the information, such as to determine which suggested changes were most frequently suggested, in order to provide a more popular redesigned product.

B. As to claims 24-26, 33 and 34, IAC discloses or suggests that the information includes problems using and usability of the product (complaints, bug reports), solutions to problems, user-suggested improvements and expansion of business relationships (ideas for new products and features).

C. As to claims 27-31, 35 and 38, this information (demographics, how the product is used, desirability of proposed changes, etc.) is typical of the type of information recovered from customers in product surveys and other information gathering means. One skilled in the art would have been motivated to incorporate them here for the same reasons they are collected using other means.

D. The rejection presented above clearly also can be applied to claims 1, 8 and 12. As to the triggering mechanism, it would have been obvious to provide a triggering mechanism, such as the send button on electronic mail, to trigger collection of the information because of the widespread use of electronic mail for transmitting information over the Internet at the time of

Art Unit: 2411

Applicant's invention. Mail sent from the service to users, asking for information, would meet the limitations of claim 8.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R. Yount whose telephone number is (703) 306-2906. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:00 AM to 5:00 PM.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached at (703) 305-9711. The fax phone number for this Group is (703) 305-9731.

8. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose phone number is (703) 305-3800.

S. Y.

Steven R. Yount
February 14, 1997


GAIL O. HAYES
SUPERVISORY PATENT EXAMINER
GROUP 2400